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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,659	01/24/2002	Kazushii Torii	43379	8146

1609 7590 09/24/2004

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/053,659	Applicant(s) TORII ET AL.	
	Examiner Ana L. Woodward	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/24/2002, 4/9/2002, 4/23/2004, 6/22/2004
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-81 is/are pending in the application.
- 4a) Of the above claim(s) 37-47, 51, 52, 57, 58, 64, 65, 71, 72 & 74-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 48-50, 53-56, 59-63, 66-70, 73 & 78-81 is/are allowed.
- 6) ☒ Claim(s) 48-50, 53-56, 59-63, 66-70, 73 & 78-81 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☒ Claim(s) 37-81 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u> </u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/24/02, 4/23/04</u> | 6) <input type="checkbox"/> Other: <u> </u> |

DETAILED ACTION

Modified Election/Restrictions

1. In light of Applicants' comments submitted June 22, 2004, the restriction requirement mandated in the last office action has been modified as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 37-47, 51, 52, 57, 58, 64, 65, 71, 72 and 74-77, drawn to a two-component system, classified in class 525, subclass various.
- II. Claims 48-50, 53-56, 59-63, 66-70, 73 and 78-81, drawn to a one-component system, classified in class 524, subclass various.

2. The inventions are distinct, each from the other because:

Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a molding or coating composition in and of itself without the presence of additional resin materials which would react in-situ to produce a mutually exclusive final product and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior

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art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Applicant's election with traverse of Group II in the reply filed on June 22, 2004 is acknowledged. The traversal is on the ground(s) that the action does not identify which of the claims are directed to an intermediate and which are directed to the final product. In response, it maintained that the claims containing one component constitute the intermediate product and the claims containing more than one component constitute the final product. Applicants have not submitted evidence or identified such evidence now of record showing the species to be obvious variants or clearly admitted on the record that this is the case. The requirement is still deemed proper and is therefore made FINAL.

4. Claims 37-47, 51, 52, 57, 58, 64, 65, 71, 72 and 74-77 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 22, 2004.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 48-50, 53-56, 59-63, 66-70, 73 and 78-81 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 95/22358.

The reference discloses absorbent structures and materials comprising a mixture of (1) a plurality of absorbent gelling particles comprising a water-insoluble, water-swellaable polymer, and (2) an absorbent property modification polymer. Most preferred polymer materials for use in making the water-insoluble, water-swellaable polymer are surface cross linked hydrogel-forming absorbent polymers, examples of such are partially neutralized polyacrylic acids meeting the requirements of applicants' acrylic acid and/or salt -based polymer (page 14, lines 24-37). See working examples, which demonstrate various absorbent materials meeting the terms of the present claims with respect to the types of materials added.

It is reasonably believed that the absorbent materials of the reference, being essentially the same as applicants', would inherently meet all property limitations governing the present claims. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

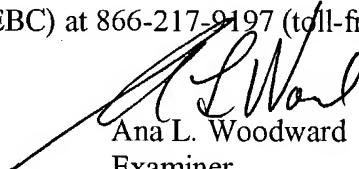
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward
Examiner
Art Unit 1711

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